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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/640,750	08/18/2000	Thomas R. Marotta	1960.213	7654

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EXAMINER

HO, UYEN T

ART UNIT

PAPER NUMBER

3731

DATE MAILED: 01/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/640,750

Applicant(s)

MAROTTA ET AL.

Examiner

(Jackie) Tan-Uyen T. Ho

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-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 November 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Marotta et al. (6,261,305). Marotta et al. disclose an expandable endovascular prosthesis (fig. 23 and col. 12, lines 25-54).

In regard to claim 1-27, the prosthesis includes: A body is constructed from a plastically deformable material, self-expanding material and a biodegradable material (col. 7, lines 40-62), the body having:

- A first expandable portion (435) having a porous surface,
- A second expandable portion having a porous surface (425),
 - The porous surface is defined by a plurality of interconnected struts (426, 427, 428, 429).
 - The interconnected struts include a plurality of first struts (426, 427) and a plurality of second struts (429) disposed at an acute angle with respect to

the first struts. The first struts (426, 427) are connected to a first edge of the first expandable portion (fig. 23) and the second struts (429) are not directly connected to the first expandable portion (435) but they are connected to the first expandable portion (435) via the first strut (426).

- The first edge includes a circumferentially meandering pattern having a plurality of apices with a first set of convex apices and a second set of concave apices alternate with respect to one another.
- A third expandable portion (440) having porous surface and connected to the first expandable portion by at least one strut (450).
- An elastic member (460) covers at least a portion of the porous surface having a first surface area being greater than a second surface area of the second expandable portion (425).

In regard to claim 29, Marotta et al. disclose a method for endovascular blocking of an aneurismal opening with the prosthesis (col. 14, lines 34-50 including the step of:

- Disposing the prosthesis on a catheter,
- Inserting the prosthesis and catheter within a body passage way to a target vascular lumen at which the aneurysm opening is located,
- Exerting a radially outward expansive force to expand the first portion against the target body passageway and the second portion against the aneurysm opening thereby blocking the aneurismal opening.

In regard to claim 30, since Marotta et al. disclose the prosthesis, as claimed, the method for producing the prosthesis the steps of expanding the second expandable

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portion, affixing the covering material to the second expandable portion and compressing the second expandable portion is inherent.

Response to Amendment

3. Applicant's arguments filed 11/18/2002 have been fully considered but they are not persuasive. The applicant argued that the art applied by the Examiner fails to disclose or suggest "the first surface area is greater than the second surface area in the unexpanded state of the second expandable portion." Examiner respectfully disagrees with respect to the applicant's claimed invention.

Each of the independent claims 1, 29, 30 recites "a covering material having a first surface area disposed over a second surface area of the second expandable portion, the first surface area being greater than the second surface area in the second unexpanded state of the second expandable portion"

In figure 23 of the Marotta et al. '305 reference, the second surface area of the second expandable portion (425) includes the surface of struts (426, 427, 428, 429). The first surface area of the cover (460) includes the surface area of the cover (460) covering the struts (426, 427, 428, 429, col. 12, lines 32-54) and the surface of the cover extending between porous areas between the struts. Thus, in both unexpanded and expanded states of the second expandable portion, the first surface area equals the second area (the surfaces of the struts) plus the area between the struts.


Conclusion


4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to (Jackie) Tan-Uyen T. Ho whose telephone number is (703) 306-3421. The examiner can normally be reached on MULTIFLEX Mon. to Sat.. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael J. Milano can be reached on (703) 308-2496. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3590 for regular communications and (703) 305-3590 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.


(Jackie) Tan-Uyen T. Ho
January 8, 2003


GARY JACKSON
PRIMARY EXAMINER
GROUP 3300